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William Nelson Davis

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BREINER & BREINER, L.L.C.

P.O. BOX 320160

ALEXANDRIA, VA 22320-0160

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FABER, DAVID

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WILLIAM NELSON DAVIS and STEVEN JOHN KUHLMAN

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Appeal 2009-009743  
Application 10/621,275<sup>1</sup>  
Technology Center 2100

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Decided: March 24, 2010

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*Before* LANCE LEONARD BARRY, JAY P. LUCAS, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 6, 10, 11, 13, 14, and 17 to 21 under authority of 35 U.S.C. § 134(a). The Board of Patent

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<sup>1</sup> Application filed July 17, 2003. Appellants claim the benefit under 35 U.S.C. § 119 of provisional application 60/452,576, filed 3/6/03. The real party in interest is Monotype Imaging, Inc.

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Application 10/621,275

Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

An Oral hearing was held on March 16, 2010.

We affirm the rejections.

Appellants' invention relates to a system and method for renting type fonts. In the words of Appellants:

A font rental system provides a system for the licensing of font software, using a rental model. This differs from the conventional techniques for distributing fonts, which requires their purchase and permanent installation onto a computer. The font is delivered to the end user or font consumer. It provides for the ability to control the degree to which the end users can access the font and how long it is available to them. As a result, the cost can be reasonable and the user is not forced to license more than they require.

(Spec. 15).

Claim 1 is exemplary and is reproduced below:

1. A method for the distribution of fonts by rental, the method comprising:

a font consumer requesting a font from a font provider;

the font provider accessing subscription information for the font consumer;

the font provider sending the requested font to the font consumer depending on the subscription information, the font provider giving lifetime information with the requested font, the lifetime information defining a predetermined period of

time for which the font consumer is authorized to use the requested font and defining a predetermined access for use based on the subscription information; and

the font consumer receiving the requested font and providing the requested font to an application by installing the requested font in the font consumer for the predetermined period of time and for the predetermined access, wherein the required font is tracked so that upon expiration of said predetermined period of time, the font is disabled.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Barron	US 2001/0042124 A1	Nov. 15, 2001
Nagy	US 2003/0119478 A1	Jun. 26, 2003
Ying	US 6,853, 980 B1	Feb. 08, 2005
Hayes	US 6,882, 344 B1	Apr. 19, 2005

### REJECTIONS

The Examiner rejects the claims as follows:

R1: Claims 1 to 3, 6, 10, and 18 to 20 stand rejected under 35

U.S.C. § 103(a) for being obvious over Ying in view of Hayes.

R2: Claim 4 stands rejected under 35 U.S.C. § 103(a) for being obvious over Ying in view of Hayes and further in view of Nagy.

R3: Claims 5 and 21 stand rejected under 35 U.S.C. § 103(a) for being obvious over Ying in view of Hayes and further in view of Barron.

R4: Claims 11, 13 and 17 stand rejected under 35 U.S.C. § 103(a) for being obvious over Ying and Hayes.

R5: Claim 14 stands rejected under 35 U.S.C. § 103(a) for being obvious over Ying and Hayes and further in view of Barron.

Appellants contend that the claimed subject matter is not rendered obvious by Ying and Hayes alone, or in combination with Nagy or Barron, for failure of the references to teach a key limitation. The Examiner contends that each of the claims is properly rejected.

In view of the arguments, the rejections will be reviewed together. The claims are grouped as per Appellant's Briefs. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue specifically turns on whether the references teach a method or system for distributing or managing fonts by rental, with the features expressed in the claims.

### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellants have invented a system and method for distributing fonts to consumers through what is disclosed to be electronic distribution means

and steps (Spec. 8, bottom). In accordance with a rental model, the provider rents the font to the user for a set period of time (Spec. 9, bottom). A font tracker uninstalls or otherwise disables the font at the end of the timer period set by the lifetime information from the provider (*Id.*).

2. Ying teaches a method of selling fonts to consumers through e-commerce (Col. 2, l. 60). Fonts can be tested before purchase to see if they conform to the user's expectations (Col. 4, l. 57). Licenses control the use of the font by the consumer, which licenses include limitations on the right to use, including "on the length of time for which they can be used." (Col. 30, ll. 29, 30).
3. Hayes also teaches a method for distributing fonts, including replacing electronic font files that have become corrupted (Col. 3, ll. 28 to 38). Included is a mechanism for sending available fonts to a consumer to allow the consumer to sample a font. At the end of the sampling period, if the font is not purchased it is disabled (Col. 8, l. 47).

## PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary

indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“A reference does not fail as an anticipation merely because it does not contain a description of the subject matter of the appealed claim in *ipsissimis verbis*.” *In re May*, 574 F.2d 1082, 1090 (CCPA 1978) (citing *In re Schaumann*, 572 F.2d 312, 317 (CCPA 1978)).

## ANALYSIS

From our review of the administrative record, we find that the Examiner presents his evidence for the rejections on pages 3 to 13 of the Examiner’s Answer. In opposition, Appellants present a number of arguments, all of which are applicable to all of the rejections (App. Br. 9 to 13). We will thus consider the rejections [R1 to R5] together.

*Arguments with respect to the rejection  
of claims 1 to 6, 10, 11, 13, 14 and 17 to 21  
under 35 U.S.C. § 103(a) [R1-R5]*

Appellants first argue that the Examiner has equated the claimed renting of fonts with the disclosure in the references of borrowing, lending and selling of fonts (App. Br. 9, top). A rejection is not an *ippismus verbis* process, and if the references teach all of the claimed steps or elements, we

will not quibble about the verb. (*See In re May*, cited above, albeit in an anticipation context.) Our inquiry will focus on whether the references teach the claimed limitations.

Appellants contend that Ying “provides no description as to how to provide or implement or enforce a license or sale including limitations.” (App. Br. 9, bottom). The Examiner has expressed how Ying does teach restrictive licenses being included with the sale of fonts (Ans. 11, bottom). These restrictions include the “length of time for which they could be used.” (Col. 30, ll. 29, 30). For a teaching of enforcement of the license, the Examiner has used a teaching in the Hayes reference: “In this instance, a font for sale may be sent with timeout information, thus allowing a user to sample the font for a period of time and when the time expires disabling the font.” (Ans. 11, middle; col. 8, ll. 46 to 48). The disabling is done by a font manager application #706 pursuant to the timeout information accompanying the font (Col. 7, l. 21). The combination of teachings, we find, render obvious the subject claim limitation.

At the oral hearing on March 16, 2010, the Appellants argued that the Hayes’ teaching referred to distributing non-activated fonts, pointing to column 10, line 40, of Hayes. We find that Hayes does have that teaching, however as an alternative to the teaching cited by the Examiner and described just above. The Examiner properly relied upon the column 8 teaching.

As all of the rejections are argued by Appellants using logic similar to the above, we are not persuaded that the Examiner erred in rejections [R1 to R5].



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### CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 6, 10, 11, 13, 14 and 17 to 21.

### DECISION

The Examiner's rejections [R1 to R5] of claims 1 to 6, 10, 11, 13, 14 and 17 to 21 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

BREINER & BREINER, L.L.C.  
P.O. BOX 320160  
ALEXANDRIA, VA 22320-0160